Remarks

Claims 6-28 are in the application. Claim 6, 17, and 21 are in independent form. All claims stand rejected.

Drawings

The Examiner objects to the drawings for failure to show every step in the methods of claims 6 and claim 21. A drawing is required "where necessary for the understanding of the subject matter sought to be patented." 37 C.F.R. 1.81(a); 35 U.S.C. 113. M.P.E.P. 604.01(f) states: "It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence)." Applicant submits that no drawing is necessary to understand the method steps recited, and simply adding the claim words to a flow chart would not enhance understanding of the claimed invention.

Nevertheless, applicant submits that an embodiment of "automatically accepting" is shown in FIG. 6, steps 128 and 140, an embodiment of "automatically publishing" and "automatically and immediately making publicly available" is shown in step 140.

Rejection under 35 U.S.C. § 112

Claims 13 and 17-20 stand rejection under 35 U.S.C. § 112 for indefiniteness.

Claim 13 is amended to state a method step, and claim 17 is clarified by using the terms "first computer instructions" and "second computer instructions." In today's object-oriented programming environment, it can be meaningless to try to characterize a group of computer code as a single program or as multiple interacting programs. The amended language makes it unnecessary to characterize the computer instructions as one program or two.

Rejections under 35 U.S.C. 102

Claims 17-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US. Pat.

No. 5,864,604 to Moen et al.

Moen et al. does not disclose "a program executing on the network server to automatically publish on the computer network information about the donation, thereby providing immediate recognition to the donor."

The examiner states in paragraph 22 that the only positive limitations in claim 17 are a network server and a first program. The Examiner has ignored the function of the program because it fails "to add any structural limitations and are thereby regarded as intended use language." The examiner states that applicant's claimed invention is not doing anything, it is merely capable of doing something.

Applicant submits that the Examiner's Office position in incorrect. In WMS Gaming, the Federal Circuit stated: "The structure of a microprocessor programmed to carry out an algorithm is limited by the disclosed algorithm. A general purpose computer, or microprocessor, programmed to carry out an algorithm creates 'a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.' In re Alappat, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (en banc); see In re Bernhart, 417 F.2d 1395, 1399-1400, 163 USPQ 611, 615-16 (CCPA 1969) ('[I]f a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged.')."

Thus, a computer that is programmed to perform a function is a special purpose apparatus and, like any other apparatus, a claim directed to it does not need to recite that the apparatus is doing something. The program makes the computer a unique structure. The programming becomes part of the structure of the programmed computer and not merely an intended field of use. To require the programmed structure to be operating is like requiring a claim to a hammer to recite that the hammer is hammering nails.

To expedite allowance, however, applicant has amended claim 17 to recite that the computer instructions are "accepting" and "publishing."

The prior art does not teach a computer automatically accepting donations over the computer network, automatically publishing on the computer network information about the donation to provide immediate recognition to the donor, and automatically accepting from donors additional donations spurred by the immediate public recognition. Thus, the prior art does not teach the claimed invention.

Rejections under 35 U.S.C. 103

Claims 6-12, 16, 21, 22, 27, and 28 stand rejected under 35 U.S.C. § 103(a) for obviousness over either Moen et al., Ziarno '902, or Ziano 393, in view of U.S. Pat. No. 5,727,156 to Herr-Hoymann et al. The examiner states that Moen et al. discloses automatically accepting donations over a computer network and Herr-Hoymann teaches a system for publishing documents on the Internet.

The Examiner states that the claim elements missing in the combination of Moen and Herr-Hoymann are "descriptive material" and not functionally involved in the steps claims. Amended claims 6 and 17 include an additional step that depends on the "donation information" that is published, so the "donation information" can no longer be considered "descriptive material."

In the Office's "Examination Guidelines for Computer-Related Inventions," (the Guidelines) the first step is to "Determine What Applicant Has Invented and Is Seeking to Patent." Section II. Claim 6, for example, is a method for increasing charitable donations. The Examiner is ignoring the core of what applicant has invented and the claimed utility of the invention by calling it "descriptive material not functionally involved in the steps of the method." Applicant submits that publishing a donor list is most certainly "functionally involved" in the process of increasing charitable donations. Accepting donations and publishing them provides immediate positive feedback and incentive for other to match the donation.

The Office's "Examination Guidelines for Computer-Related Inventions," section VI, states that a rejection is proper for "a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed to

achieve the utility of the invention." [Emphasis added]. The Guideline provides an example: "Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of non-functional descriptive material."

In the present case, the prior art does not address the utility of the claimed invention. The prior art does not suggest a method of increasing charitable donations by providing immediate recognition and increasing competition between donors. The claimed invention is not simply a rearrangement of non-functional descriptive material.

To expedite allowance, applicant adds an element to each independent claim to explicitly recite an effect that depends on the content of the published information.

Herr-Hoymann describes a system for posting documents on the Internet. It does not teach or suggest posting automatically posting donation information to encourage further donations. Neither reference teaches publishing donor information to promote competition and increase donations. Applicant submits that it is only in hindsight from applicant's specification that the Examiner alters Herr-Hoyman and combines it with the other references to achieve applicant's invention.

Applicant submits that the application is in condition for allowance and respectfully requests that application be allowed.

Respectfully submitted,

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Marked-up paragraph beginning on page 7, line 14of the specification:

Fig. 6 is a flow chart showing the steps for making a donation in accordance with the present invention. Step 86 shows that a donor accesses home page 38 using Web browser 24 n a computer 16. Step 88 shows that the donor selects appropriate links to reach a donation screen shown in FIG. 9 [92]. For example, the donor may select[s] donor recognition page link 46 from home page 38 and then select a donate link 62 from donor recognition page 60. Upon selecting the donate link 62, the donor is connected to a secure area of server 20 to protect the confidentiality of personal and financial information that will be transmitted.

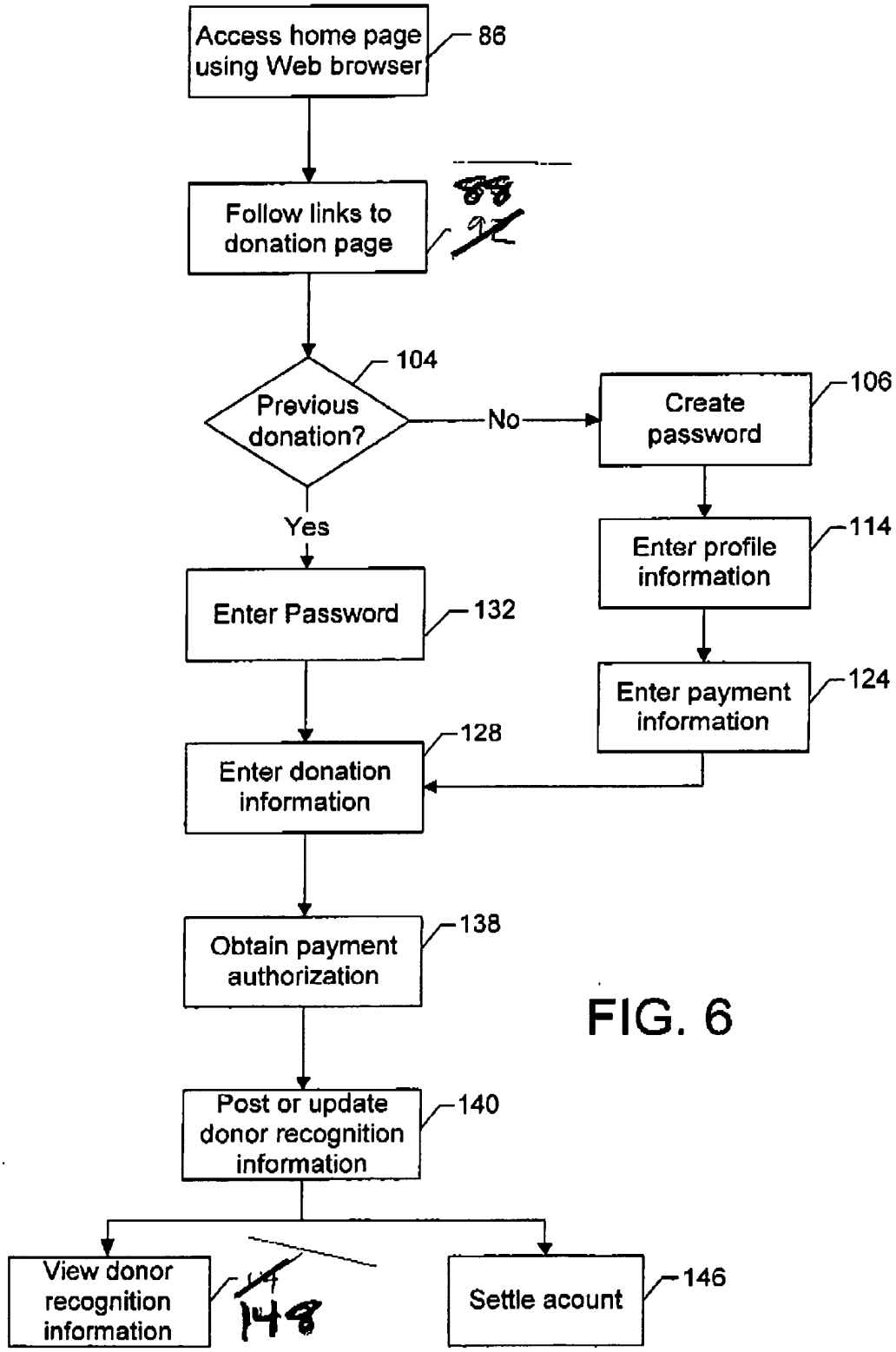
Access home page using Web browser
86
Follow links to donation page
104
Previous donation?
No
106
Create password
Yes
114
Enter profile information
Enter Password
132
124
Enter payment information
128
Enter donation information
138
Obtain payment authorization
140
Post or update donor recognition information
View donor recognition information
148
146
Settle acount

FIG. 6